

REMARKS

The Final Official Action dated November 15, 2005 has been carefully reviewed. Claims 1-51 are pending in this application. Applicants request reconsideration of this application in light of the remarks presented herein.

CLAIM REJECTIONS BASED ON § 103 - CAREN/MAYFIELD

In the final official action dated November 15, 2005, claims 1-7, 9, 11-16, 18-24, and 49-51 were rejected by the Examiner under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 6,321,531 to Caren et al. ("Caren") in view of U.S. Patent No. 5,264,803 to Mayfield ("Mayfield").

A. The Rejections of Claim 1 and 49

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The Examiner rejected claims 1 and 49 under 103(a) alleging that Caren discloses:

[A] circuit for providing a potential difference across a gap between two electrodes of a utilization device (e.g. 30, 40, 50, 70, 80, 100, 110, 130, 170, 1020), the circuit including a power source

(e.g. 1000), a transformer (e.g. 1022) including a primary winding (e.g. 1034) and a secondary winding (e.g. 1036) for coupling across the electrodes (e.g. 101, 102, 174, 176), the power source coupled to the primary winding, a first switch coupled to one of the two terminals of the primary winding, and a second switch coupled to the other of the two terminals of the primary winding (e.g. 1032) (e.g. See col. 32, lines 24-67; cols. 33-35, lines 1-67; col. 36, lines 1-53). However, Caren fails to disclose the secondary winding having universal winding configuration and wound in sections.

The Examiner further alleges that Mayfield teaches that it is conventional in the art, to use a transformer including a secondary winding having a universal winding configuration and wound in sections. The Examiner contends that it would have been obvious to one of ordinary skill in the art at the time the invention was made, to use a transformer including a secondary winding having a universal winding configuration and wound in sections of Caren, as taught by Mayfield for the purposes of reducing intra-winding capacitance and electric field, so as to further improve the performance and the efficiency of the transformer.

During the February 7, 2006 telephone interview the Examiner stated that he interpreted the term "universal winding" as meaning any type of winding without evidence to the contrary. Applicants asserted that a "universal winding" is a particular winding configuration known for decades as being used extensively in the radio field. Applicants now submit evidence in support of this assertion in an Information Disclosure Statement (IDS) accompanying this response. For example, the article "Winding the Universal Coil" contains a summary providing: "Details of how to calculate the various factors entering into the winding of universal coils used with such great frequency in modern radio receivers." A.W. Simon, Ph.D., *Winding the Universal Coil*, 9 Electronics 22, 22 (1936) . Also included are the articles entitled "The Design of the Universal Winding" and "Universal Coil Winding", which appear in radio engineering journals. Note also

the large list of articles in the bibliography of "Universal Coil Winding", which are directed to "universal windings."

These articles clearly support the notion that a "universal winding configuration" is a term of art. As a result, the Examiner's interpretation of the term as "any winding configuration" is improper. Therefore, the Examiner has failed to identify a "universal winding" configuration in either Caren or Mayfield, and thus has not established a prima facie case of obviousness.

The Examiner has also failed to establish any legally sufficient suggestion or motivation to combine Caren and Mayfield in those references or in the knowledge generally available to one of ordinary skill in the art, which is also required to establish a prima facie case of obviousness. The Examiner merely provided the unsupported, conclusory statement that the references should be combined "for the purpose of reducing intra-winding capacitance and electric field, so as to further improve the performance and the efficiency of the transformer", but has failed to identify where such a purported motivation can be found in the prior art. The intra-winding/electric field line of motivation appears to be derived solely from remarks submitted by Applicants in a previous office action response.

Because of this, it appears that the Examiner has clearly engaged in hindsight reconstruction in his attempt to combine these two references, which is improper. If the Examiner continues to allege that the combination of Caren and Mayfield establish a prima facie case of obviousness, the Applicants would appreciate that the Examiner specifically cite to the portions of the reference(s) that establish the motivation or suggestion for combination.

In light of the Examiner's current position, Applicants respectfully believe a prima facie case of obviousness has not been established. Therefore, the rejections of claim 1 and 49 should be withdrawn by the Examiner.

B. The Rejections of Claim 2-7, 9, 11-16, and 18-24

Claims 2-7, 11-16, and 18-24 are either directly or indirectly dependent upon claim 1. As a result, claims 2-7, 11-16, and 18-24 should be allowed for at least the reasons discussed in regard to claim 1.

C. The Rejections of Claims 50 and 51

Claims 50 and 51 are directly dependent upon claim 49. As a result, claims 50 and 51 should be allowed for at least the reasons discussed regarding claim 1.

CLAIM REJECTIONS BASED ON § 102 - CAREN

In the final official action dated November 15, 2005, claims 25-48 were rejected by the Examiner under 35 U.S.C. § 102(b) as being anticipated by Caren.

A. The Rejection of Claim 25

MPEP § 2131 provides that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

The Examiner rejected independent claim 25 alleging that Caren teaches all of the elements contained in claim 25. Among the elements allegedly taught in Caren, the Examiner specifically states that Caren teaches:

[A] circuit for providing a potential difference across a gap between two electrodes of a utilization device (e.g. 30, 40, 50, 70, 80, 100, 110, 130, 170, 1020), the circuit including a power source (e.g. 1000), a transformer (e.g. 1022) including a primary winding (e.g. 1034) and a secondary winding (e.g. 1036) for coupling across the electrodes (e.g. 101, 102, 174, 176), the power source coupled to the primary winding, a first switch coupled to one of the two terminals of the primary winding, and a second switch coupled to the other of the two terminals of the primary winding (e.g. 1032) (e.g. See col. 32, lines 24-67; cols. 33-35, lines 1-67; col. 36, lines 1-53).

The Examiner's statement that all of the elements are disclosed in Caren is incorrect, and thus the rejection should be withdrawn. For example, Caren fails to disclose a secondary winding wound in sections. Therefore, the Examiner has not shown that Caren anticipates claim 25. As a result, the Examiner should withdraw his rejection of claim 25.

B. The Rejections of Claims 26-48

Claims 26-48 are either directly or indirectly dependent upon claim 25. As a result, the rejections of claims 26-48 should be withdrawn for at least the reasons discussed in regard to claim 25.

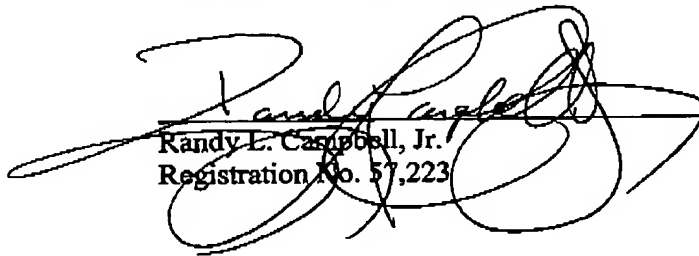
CONCLUSION

In view of the foregoing remarks, it is submitted that this application is in condition for allowance. Action to that end is hereby solicited.

It is respectfully requested that this paper be considered as a Petition for an Extension of Time sufficient to effect a timely response. It is further requested that any shortages in extension of time fees or other fees be charged, or any overpayment in fees be credited, to the Account of Barnes & Thornburg LLP, Deposit Account No. 10-0435 with reference to file 9501-73714.

Respectfully submitted,

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